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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,460	06/05/2001	Dan Kikinis	004688.P024	6281

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EXAMINER

LAYE, JADE O

ART UNIT PAPER NUMBER

2614

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/875,460

Applicant(s)

KIKINIS, DAN

Examiner

Jade O. Laye

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/31/02, 6/5/01, 8/28/01, 7/19/01</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statements (IDS) submitted on 6/5/01, 7/19/01, 8/28/01, and 1/31/02 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements have been considered by the examiner.

Drawings

2. The drawings are objected to because the system components are not descriptively labeled. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 9, 10, 17, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Girard et al. (US Pat. No. 5,751,282).

As to claim 1, Girard et al disclose a system in which EPG selections are transmitted to a set top box via a separate wireless remote control. Once requested, a head end server unit retrieves and transmits the requested broadcast programming stored on its database. (Abstract; Col. 2, Ln. 5-40; Col. 3, Ln. 55-64). Accordingly, Girard et al anticipate each and every limitation of claim 1.

Claims 9 and 17 correspond to the method claim 1. Therefore, each is analyzed and rejected as previously discussed.

As to claim 2, Girard et al further teach an EPG media server resident at the head end server, maintains a program reserve. (Col. 2, Ln. 18-40). Accordingly, Girard et al anticipate each and every limitation of claim 2.

Claims 10 and 18 correspond to the method claim 2. Therefore, each is analyzed and rejected as previously discussed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. Claims 3, 11, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Girard in view of Russo. (US Pat. No. 5,619,247).

Applicant's claim 3 recites the method of claim 1, further including storing the EPG selections on a set top box (STB). As discussed above, Girard contains all limitations of claim 1, but fails to specifically disclose the limitations recited in claim 3. However, within the same field of endeavor, Russo discloses a STB capable of storing video and audio programs. (Abstract). Therefore, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to combine the systems of Girard and Russo in order to provide a system capable of storing EPG selections at the subscriber site, thereby allowing an alternate method of storage.

Claims 11 and 19 correspond to the method claim 3. Accordingly, each is analyzed and rejected as previously discussed.

5. Claims 4, 12, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Girard in view of Huang et al. (US Pat. No. 6,437,836).

Applicant's claim 4 recites the method of claim 1, further including receiving EPG selections entered via a separate wireless personal device assistant (PDA). As discussed above, Girard discloses all limitations of claim 1, but fails to specifically disclose the limitations of claim 4. However, within the same field of endeavor, Huang et al disclose a similar system in which a PDA can be used to transmit EPG data. (Abstract; Col. 3, Ln. 55-65; Figs. 1 & 5). Accordingly, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to combine the systems of Girard and Huang in order to provide a remote terminal with extended functionality, thereby allowing the user to request/reserve programming on the remote terminal instead of the television display.

Claims 12 and 20 correspond to the method claim 4. Therefore, each is analyzed and rejected as previously discussed.

6. Claims 5, 13, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Girard in view of Elliot. (US Pat. No. 6,473,097).

Applicant's claim 5 recites the method of claim 1, further including receiving EPG selections entered via a separate wireless web phone. (Note: the Examiner interprets "wireless web phone" to mean any wireless phone having internet access.) As discussed above, Girard et

al disclose all limitations of claim 1, but fail to specifically teach the limitations of claim 5. However, within the same field of endeavor, Elliot discloses a cellular phone which can receive/transmit data over the internet via radio frequencies. (Col. 3, Ln. 36-46 & Col. 4, Ln. 36-46). Accordingly, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to combine the systems of Girard and Elliot in order to provide a system capable of requesting EPG data via a mobile phone, thereby providing the user with an apparatus which allows him or her to reserve programs from remote locations.

Claims 13 and 21 correspond to the method claim 5. Thus, each is analyzed and rejected as previously discussed.

7. Claims 6-8, 14-16, and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Girard in view of Terakado et al. (US Pat. No. 6,246,441).

Applicant's claim 6 recites the method of claim 1, further including transmitting the EPG selections to the separate wireless remote to be displayed on the wireless remote when requested. As discussed above, Girard teaches all limitations of claim 1, but fails to specifically recite those limitations recited in claim 6. However, within the same field of endeavor, Terakado et al disclose a similar system in which a broadcasting station transmits an EPG to a remote device. (Abstract; Col. 4, Ln. 29-42; Col. 9, Ln 49-53). Accordingly, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to combine the systems of Girard and Terakado in order to provide a system capable of reserving/requesting EPG data on a remote terminal, thereby providing the user with remote access to such data.

Claims 14 and 22 correspond to the method claim 6. Therefore, each is analyzed and rejected as previously discussed.

Note: the Examiner recognizes Terakado teaches transmittal of the EPG data from the broadcasting station to the receiver, then to the remote terminal. Broadly interpreted, applicant's claim 6 could be read to refer to direct transmittal from the broadcasting station to the remote terminal. However, in view of the ordinary knowledge in the art at the time of applicant's invention, this would be an obvious variant. As evidenced by Schultz et al US Pat. No. 5,679,943, hand held terminals capable of receiving RF signals were well known in the art at the time of applicant's invention. Therefore, if applicant were to argue accordingly, this rejection would be made. (In the alternative, Nelson US Pat. No. 5,710,605 discloses a remote, which receives EPG data directly from the content provider via a modem.)

Note: Applicant's claim 6 could also be read to refer to actual display of EPG broadcasts on the separate remote terminal. However, applicant's specification provides no support for such an interpretation. Therefore, the Examiner interprets EPG selections in claim 6 to refer only to channel information, not the actual channel broadcast.

Applicant's claim 7 recites the method of claim 6, further including transmitting the EPG selections to multiple separate wireless remotes to be displayed concurrently on the wireless remotes when requested. As discussed above, the combined systems of Girard and Terakado contain all limitations of claim 6, and further contain all limitations of claim 7 as well. In light of the combined disclosures used to reject claim 6, claim 7 would be an obvious variant. Transmitting EPG data to multiple remote terminals is obvious in light of a disclosure already

teaching transmittal to one remote terminal. Therefore, the combined systems of Girard and Terakado contain all limitations of claim 7.

Claims 15 and 23 correspond to the method claim 7. Accordingly, each is analyzed and rejected as previously discussed.

Applicant's claim 8 recites the method of claim 6, further including transmitting one or more programs to be separately displayed concurrently with displaying the EPG selections. As discussed above, the combined teachings of Girard and Terakado contain all limitations of claim 6, while Terakado further teaches his system is capable of allowing a user to view a program broadcast on the television while concurrently viewing the EPG data on the remote terminal. (Col. 9, Ln. 47-53). Therefore, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to further modify the combined system of Girard and Terakado to also provide for a system capable of allowing the user to view broadcast programs simultaneously while viewing EPG data. This would allow other persons to continue viewing the broadcast without being disturb by the one viewer who desires to search the EPG data.

Claims 16 and 24 correspond to the method claim 8. Therefore, each is analyzed and rejected as previously discussed.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Escobar et al (US Pat. Pub. No. 2002/0053084) disclose an EPG capable of storing program selections at the subscriber site.

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- b. Nelson (US Pat. No. 5,710,605) discloses a remote, which displays an EPG received directly from the content provider.
- c. Darbee et al (US Pat. No. 6,130,726) disclose a remote capable of displaying an EPG.
- d. Shintani et al (US Pat. No. 6,532,592) disclose a remote capable of displaying an EPG.
- e. Gudorf (US Pat. No. 6,313,887) discloses a remote capable of displaying data.
- f. Shen et al (US Pat. No. 6,401,059) disclose a PDA capable of displaying an EPG.
- g. Croy et al (US Pat. No. 6,509,908) disclose a remote capable of displaying an EPG.
- h. Kim (US Pat. No. 6,556,771) discloses a remote capable of displaying an EPG.
- i. Sorensen (US Pat. No. 6,628,729) discloses a remote capable of displaying an EPG.
- j. Maissel et al (US Pat. No. 6,637,029) disclose an intelligent EPG.
- k. Grooters (US Pat. No. 6,862,741) discloses a remote capable of displaying an EPG.

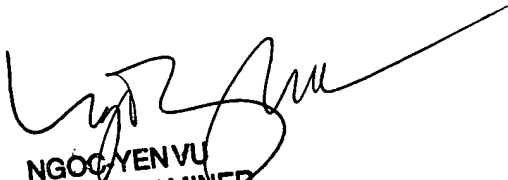
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jade O. Laye whose telephone number is (571) 272-7303. The examiner can normally be reached on Mon. 7:30am-4, Tues. 7:30-2, W-Fri. 7:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner's Initials JL
March 24, 2005.


NGOC YEN VU
PRIMARY EXAMINER